

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB OCT. 21, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Vepe Industria Alimentica Ltda.**

Serial No. 75/106,443

Robert C. Faber and Marc A. Lieberstein of **Ostrolenk, Faber, Gerb & Soffen, LLP** for **Vepe Industria Alimentica Ltda.**

Jennifer D. Richard, Trademark Examining Attorney, Law Office 101
(**Jerry Price**, Managing Attorney).

Before **Seeherman, Quinn and Hohein**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Vepe Industria Alimentica Ltda has filed an application
to register the mark NO "NO SUGAR, in the stylized format shown
below,

for "dietetic foods, namely candies without added sugar".¹

¹ Ser. No. 75/106,443, filed on May 20, 1996, which alleges a bona fide
intention to use the mark in commerce. The words "NO SUGAR" are

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark NO-NO, which is registered for "cookies,"² as to be likely to cause confusion, mistake or deception.³

Applicant has appealed. Briefs have been filed,⁴ but an oral hearing was not requested. We reverse the refusal to register.

Turning first to consideration of the respective goods applicant argues that its dietetic candies "are distinct from those sold under the cited registration in that they are sold for

disclaimed, and the lining is a feature of the mark and is not intended to indicate color.

² Reg. No. 1,664,286, issued on November 12, 1991, which sets forth dates of first use of January 1980; combined affidavit §§8 and 15.

³ Although registration was also finally refused, pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that applicant's mark is merely descriptive of its goods, such refusal was withdrawn in view of applicant's submission of a disclaimer of the words "NO SUGAR".

⁴ Although applicant, with its brief, submitted copies of several third-party registrations for "marks which incorporate the 'NO' designation" to show that such a designation "serves to suggest a characteristic of the goods being sold," the Examining Attorney in her brief has properly objected to consideration of such evidence as untimely under Trademark Rule 2.142(d). Moreover, it should be pointed out that a mere listing, from a commercial database, of information concerning third-party registrations is insufficient to make such registrations of record. See, e.g., *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). The proper procedure, instead, is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the Patent and Trademark Office's own computerized database. See, e.g., *In re Consolidated Cigar Corp.*, 35 USPQ2d 1290, 1292 (TTAB 1995) at n. 3; *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) at n. 3 and *In re Melville Corp.*, 18 USPQ2d 1386, 1388-89 (TTAB 1991) at n. 2. In any event, we hasten to add that even if such evidence properly formed part of the record, it would make no difference in the disposition of this appeal inasmuch as none of the registrations is for a mark which consists of or includes the term "NO-NO".

a specified use and marketed to a special type of consumer." In particular, applicant contends that customers for its goods typically are persons "with diabetes or [those] having some other dietary food requirement" and, as such, its customers "are sophisticated and usually they are careful to examine the source for their food purchases."⁵

We agree with the Examining Attorney, however, that the respective goods are closely related. Not only are applicant's dietetic candies without added sugar and registrant's cookies (including dietetic cookies)⁶ both "snacks that will be sold to the same customers in the same stores," but the Examining Attorney has made of record over a dozen use-based third-party registrations for marks which, in each instance, are registered

⁵ Applicant also raises the meritless argument that because the goods set forth in the cited registration are identified only as "cookies," the "identification is unclear and indefinite as to the type and nature of cookie being sold under the registered mark." Applicant therefore maintains that it is "improper to extend the identification of the goods to include dietetic candies," citing *In re Trackmobile Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990). However, as the Examining Attorney correctly points out in her brief, the term "cookies," which is set forth in numerous third-party registrations which are of record, "is not an indefinite identification of goods" and thus applicant's reliance on *Trackmobile*, supra, "is inapposite." Moreover, as the Examining Attorney further notes, "[t]he question is whether cookies are sufficiently related to candies with no added sugar [as] to create a likelihood of confusion when the respective marks are used" and not whether the goods listed in the cited registration are the same goods as those of applicant.

⁶ As the Examining Attorney properly observes, it is well established that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the involved application and cited registration. See, e.g., *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Here, because registrant's goods are broadly described, they would encompass dietetic cookies as well as cookies for persons without limited sugar or other dietary restrictions.

for both "candy" and "cookies". In addition, four other use-based third-party registrations list "dietetic candy" or "reduced calorie candy," on the one hand, and "cookies" or "dietetic cookies," on the other. While such registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6. In view thereof, we find that applicant's and registrant's products are closely related goods which would generally be sold through the same channels of trade to the identical classes of purchasers. If such products, therefore, were to be offered under the same or substantially similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning, then, to consideration of the marks at issue, applicant asserts that, when considered in their entirety, its stylized NO "NO SUGAR mark and registrant's NO-NO mark are different in sound, appearance and connotation and create distinctly different commercial impressions. Specifically, applicant contends that "the presence of the term 'no no' alone, which is the only common feature of the respective marks, is an insufficient basis [on which] to predicate a holding of a

likelihood of confusion" In this regard, applicant insists that:

The differences in the meanings of the respective marks are significant. A "no-no" is colloquial for something one should not do, as in "that's a no-no." It is not a term related to food, cookies or candies, but its use is broader based. Some people warn you that a particular food is a "no-no", but its being dietetic or non-dietetic are perhaps only two possible reasons for the warning.

NO "NO SUGAR, in contrast, is not written to say that the product is a "no-no", a warning to avoid the product. Nor is it a description "no sugar". It is instead a phrase suggesting something as to "sugar", maybe its absence, maybe one should avoid sugar as a "no-no", and even then the " (quotation) symbol calls any perceived meaning into question. This is what makes the NO "NO SUGAR mark arbitrary, or at least suggestive NO "NO SUGAR is simply not the same warning to avoid something, like the colloquial "no-no" as set forth in the cited registration. Rather, the Applicant's NO "NO SUGAR mark conveys a different connotation and commercial impression than the cited NO-NO registration.

The cited NO-NO mark conjures up an image of a cookie that one should not want to eat because it is fattening, e.g., "no, no don't eat that." Indeed, the phrase "no, no" is quite commonly used by parents ... to convey a sense of fear about an object or desire. To the contrary, Applicant's NO "NO SUGAR mark suggests the opposite to the purchaser, i.e., that the food may be dietetic and/or perhaps appropriate for maintaining a diet.

The Examining Attorney, on the other hand, urges that the respective marks "are similar in commercial impression because both evoke thoughts of the admonition 'that's a 'no-no.' " According to the Examining Attorney, "applicant's mark incorporates the registrant's mark and adds the [descriptive]

term SUGAR," which term "is not sufficient to overcome a likelihood of confusion". Specifically, the Examining Attorney maintains that:

Any difference in pronunciation or length of the [applicant's] mark caused by the use of the word SUGAR is negated by the fact that consumers are likely to view the term SUGAR in the mark not as a source indicator but as informational. The term SUGAR ... merely tells consumers that there is no sugar in the candy. In determining that the [respective] marks are so similar as to cause a likelihood of confusion, there is nothing improper, for rational reasons, in giving more or less weight to a particular feature of a mark, as long as the ultimate conclusion is based on consideration of the marks in their entirety. [Citations omitted.] Thus, less weight may be given to the term SUGAR without improperly dissecting the [applicant's] mark.

In addition, the presence of the term SUGAR in the applicant's mark is insufficient to change the commercial impression of the mark because it stands to reason that purchasers who are familiar with the registrant's NO-NO mark would assume that the mark NO "NO SUGAR simply reflected a new or special food variety from the same source-- i.e., foods without sugar. *In re Compania Pesquera Vikingos de Colombia, S.A.*, 221 USPQ 557 (TTAB 1984). Thus, the marks are similar in commercial impression.

We agree with applicant, however, that its NO "NO SUGAR mark projects a distinctly different overall commercial impression from registrant's NO-NO mark, thereby precluding any likelihood of confusion. As the Examining Attorney concedes in her brief, "[i]f the applicant's mark contained two quotation marks, one between the NO's and one after SUGAR--i.e., NO "NO SUGAR"--the quotation marks might serve to change the commercial impression of the mark sufficiently because the term NO SUGAR

would be set off from the word NO." Contrary to the Examining Attorney's assertion that "the quotation mark in the applicant's mark merely joins the two 'no's in the mark, just as the dash joins the 'no's in the registrant's mark," we find that the single quotation mark in applicant's mark--which we view as unusual if not unique--serves to dictate that applicant's mark would be pronounced and understood as if it were the two terms "NO" and "NO SUGAR" rather than the term "NO NO" with the added descriptive word "SUGAR". As such, the significant differences, particularly in connotation and overall commercial impression, conveyed by applicant's NO "NO SUGAR mark are sufficient to distinguish such mark from registrant's NO-NO mark, which suggestively conveys the impression that its cookies are so rich or tasty as to otherwise constitute a "no-no". Applicant's mark, in short, simply does not engender the same admonition of its dietetic candies with no added sugar being a "no-no," given the unusual or unique placement of a single quotation mark between the words "NO" and "NO" in its NO "NO SUGAR mark. Confusion as to source or sponsorship of the respective goods, even though such are closely related products, is therefore not likely to occur.

Decision: The refusal under Section 2(d) is reversed.

E. J. Seeherman

T. J. Quinn

Ser. No. 75/106,443

G. D. Hohein
Administrative Trademark Judges,
Trademark Trial and Appeal Board